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Dkt. 35997-A3ZYA/JPW/ANX

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Hung-Teh Kao, et al.	
Serial No.:	09/929,313	Group Art Unit: 1646
Filed :	August 14, 2001	Examiner: M. Brannock
For :	DNA ENCODING A HUMAN SEROTONIN ($5\text{-}HT_2$) RECEPTOR AND USES THEREOF	

1185 Avenue of the Americas
New York, New York 10036
September 10, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMUNICATION IN RESPONSE TO JUNE 10, 2003 OFFICE ACTION AND PETITION FOR A TWO-MONTH EXTENSION OF TIME

This Communication is submitted in response to the Office Action issued June 10, 2003 by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the March 10, 2003 Office Action was originally due July 10, 2003. Applicants hereby petition for a two-month extension of time in which to respond to the June 10, 2003 Office Action. The fee for a two-month extension of time for a large entity is FOUR HUNDRED AND TEN DOLLARS ($410.00) and a check in this amount is enclosed. With a two-month extension of time, a response to the June 10, 2003 Office Action is now due September 10, 2003. Accordingly, this Communication is being timely filed.

In the June 10, 2003 Office Action, the Examiner to whom the subject application is assigned required restriction under 35 U.S.C. §121 to one of the following alleged inventions:

I. Claims 1-4, 7-39 and 45, drawn to polynucleotides, vectors, and host cells, classified in class 536, subclass 23.5.

II. Claims 5 and 6, drawn to polynucleotides, classified in class 530, subclass 350.

III. Claims 40-43 and 49-51, drawn to methods of screening for ligands, classified in class 435, subclass 7.21.

IV. Claim 44, drawn to methods of identifying RNA, classified in class 435, subclass 6.

V. Claims 46 and 47, drawn to antibodies, classified in class 530, subclass 388.22.

VI. Claim 48, drawn to methods of detecting a protein, classified in class 436, subclass 501.

In support of the restriction requirement, the Examiner alleged that the inventions are distinct from each other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. §806.05 for inventive

groups that are directed to different products, restriction is deemed proper because these products appear to constitute patentably distinct inventions for the following reasons: Groups I, II, and V are directed to products that are distinct both physically and functionally, and are not required one for the other, and are therefore patentably distinct. Further, the protein of Group II can be prepared by processes which are materially different from recombinant DNA expression of Group I, such as by chemical synthesis, or by isolation and purification from natural sources. Additionally, the DNA of Group I can be used other than to make the protein of Group II, such in gene therapy or as a probe in nucleic acid hybridization assays. The protein of Group II can be used in materially different methods (e.g., in screening). Finally, although the antibody of Group V can be used to obtain the DNA of Group I, it can also be used in materially different methods, such as in various diagnostic (e.g., in as a probe in immunoasssays or immunochromatography), or therapeutic methods.

The Examiner further alleged that groups III, IV and VI are directed to methods that are distinct both physically and functionally, and are not required one for the other. Group III requires ligand-binding assays, which are not required by any of the other groups. Group IV requires an assay of nucleic acid hybridization, which is not required by any of the other groups. Group VI requires an assay of antibody binding, which is not required by any of the other groups.

The antibodies of Group V are related to the methods of Groups III and VI as product and process of use. In the instant case the antibodies are patentably distinct from each of the methods of Groups III and VI because the antibodies can be used in ways that are materially and functionally different than each of the method groups, as discussed above. Finally, the antibodies of Group V and the method of Groups IV are patentably distinct because one is not required for the use of the other.

In response, applicants hereby elect, with traverse, to prosecute the invention of Group I.

Applicants note that 35 U.S.C. §121 states, in part that "[I]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of the Groups I-VI are not independent.

Under M.P.E.P. §802.01, "independent" means "there is no disclosed relationship between the … subjects disclosed, that is, they are unconnected in design, operation, or effect… ." The claims of Groups I-VI are related in that they are drawn to the 5HT2 Receptor.

Applicants therefore respectfully assert that two independent and distinct inventions have not been claimed in the subject

application because the groups are not independent under M.P.E.P. §802.01.

SUMMARY

In view of the foregoing, applicants maintain that the June 10, 2003 restriction requirement is not proper under 35 U.S.C. § 121 and respectfully request that the Examiner reconsider and withdraw the requirement.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the enclosed fee of $410.00, is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

9/10/03

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